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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,712	12/05/2003	Tsuyoshi Masuda	3071	9956

7590 08/21/2006

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/728,712

Applicant(s)

MASUDA ET AL.

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 24, 2006 has been entered.

Repeated Rejections

2. The 35 U.S.C. 112 1st paragraph rejection of claims 1 and 7 in the office dated April 26, 2006 is repeated for the reasons of record as the arguments presented by the Applicant in the response dated July 24, 2006.
3. The 35 U.S.C. 103(a) rejection of claims 1, 3 – 7 and 9 – 11 over Nibling, Jr. in view of Shibata et al., Miro and Haase et al. in the office dated April 26, 2006 is repeated for the reasons of record as the arguments presented by the Applicant in the response dated July 24, 2006.
4. The 35 U.S.C. 103(a) rejection of claims 2 and 8 over Nibling, Jr. in view of Shibata et al., Miro, Haase et al. and Patton et al. in the office dated April 26, 2006 is repeated for the reasons of record as the arguments presented by the Applicant in the response dated July 24, 2006.

Response to Arguments

5. Applicant's arguments filed July 24, 2006 have been fully considered but they are not persuasive.

In response to Applicant's argument that the Applicant has both directly and indirectly disclosed the application of a splice tape without a release coating thereby overcoming the U.S.C. 112 1st paragraph rejection of claims 1 and 7, the specification of the application fails to give a clear definition of a silicone liner with regard to how the liner is constructed without a release coating since silicone in itself is a release material and acts a release coating for adhesive materials. If the specification is referring to only a layer of silicone by itself, Haase et al. teaches that silicone liners can be constructed from only a layer of silicone that has been cured with UV radiation (Abstract, lines 1 – 6) without a support structure and without an additional release coating. If the specification is referring to a liner formed with only a layer of silicone supported on a base structure, Miro teaches that silicone liners are constructed from a paper base coated with a layer of silicone release material (Column 2, lines 1 – 5), wherein the paper base acts as a support structure for the silicone material and does not contain any additional release material coated on the surface of the liner besides the silicone. Depending the correct interpretation of “silicone liners without a release coating”, the liner of Miro reads on the claim limitation of “silicone liners without a release coating” as Miro only contains a layer of silicone on a base substrate, support structure, without an additional coating of a release coating material, or the liner of Haase et al. reads on the claim limitation of “silicone liners without a release coating” as Haase et al. only contain a layer of silicone that has been cured with UV radiation

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without an additional support structure or an additional coating of release coating material.

Therefore, neither Miro nor Haase, as defined above, contain an additional “release coating” as part of their silicone liners and read upon the claim limitation of “silicone liners without a release coating”.

In response to Applicant’s argument that no structure similar to the claimed structure is taught or suggested and the references relied on by the Examiner which functions in a manner similar to that of the structure of the present invention to result in complete removal of the liners intact from the face layers without separation of the liners from one another, Haase et al. disclose silicone liners can be constructed from just a layer of silicone that has been cured with UV radiation (Abstract, lines 1 – 6), thereby resulting in no separation of the liners themselves since there is no release coating.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to Applicant’s argument that the present invention provides for structure not taught or suggested by any of the references or combination thereof which functions in a manner as the runnable splice in accordance with the present invention for insuring integrity of the splice by utilization of a splice tape with being greater than the third imprintable tape, Miro teaches a

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splice for pressure sensitive adhesive stock (Column 1, lines 59 – 62), wherein the splice tape (Figure 1, #2) has a width greater than said labels (Figure 1, #12) in order to insure bonding between the third printable layer and the first and second layers (Figure 1) for the purpose of forming a continuous roll is available for continued processing (Column 1, lines 7 – 9) while Patton et al. teach a printable label (Column 6, lines 5 – 7) for using for splicing together end roll materials having a width from 0.5 inches to 1 inches (Column 6, lines 15 – 20) for the purpose of splicing two rolls of material together while presenting information about the rolls of material (Column 2, line 65 to Column 3, line 2). Miro teaches a width greater than the third imprintable tape while Patton et al. shows that it is known in the art to have a splice tape within the desired width range.

Conclusion

6. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 10:00-7:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Examiner
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 8/16/06
NASSER AHMAD
PRIMARY EXAMINER